

Remarks

The following remarks are submitted in response to the Office Action mailed October 30, 2003. Claims 1, 4, and 6-18 are pending. With this Response, no claims are amended and no claims are canceled. A telephonic interview with Examiners Suhoi and Banks and Applicant's counsel, Amy Hoffman, was held on January 23, 2004. References Shaver and Van Hoose were discussed with respect to the pending claims. Briefly, Applicant's counsel argued that Shaver and Van Hoose together do not suggest Applicant's invention wherein each playpiece possesses three unique features. Applicant's arguments are detailed more fully below in this response. No agreement was made as to the outstanding rejections and no claim amendments were suggested or considered. Applicant appreciates the opportunity to discuss the rejections with the Examiners. Reconsideration and further examination of the application are respectfully requested.

Claim Rejections - 35 USC § 112

Claims 6-9 and 12 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 6, 7, 8, and 9 the Examiner argued that the structural features encompassed by the phrases "tear drop-shaped," "sun-shaped," "fire-shaped," and "ghost-shaped," respectively, can't be determined, rendering the claims indefinite.

Applicant respectfully submits that these terms are definite and fully satisfy the requirements of 35 USC 112.

First, using such shape recitations is a well-established claim practice. For instance, Shaver itself (U.S. Pat. No. 5,082,778 relied upon by the examiner) recites the shape term "teddy bear" in claim 5. (Column 6, lines 65-68 through column 7, line 2). In Shaver the term "teddy bear" was used to describe the shape of the "representational figure." In Shaver the term "teddy bear" is sufficiently definite and is no different from Applicant's use of the terms "tear drop-shaped," "sun-shaped," "fire-shaped," and "ghost-shaped." All are terms used in the vernacular of the public at large. It is not even

necessary to go to one skilled in the art to define the terms since virtually any member of the public could appreciate what is meant by each of the terms. As such, the claimed phrases are as definite as the term "teddy bear" as claimed in Shaver.

In short, even Shaver, a key reference relied upon by the Examiner, recites shape features in the claims. Yet, the Examiner has no trouble interpreting Shaver and applying it to the claims under prior art rejections discussed below. Under the same reasoning applied to the present claims, should not Shaver also be so bereft of meaning so as not to be properly applied as a reference?

Of course, Shaver is not the only patent whose claims use shape recitations. As just a few of many representative examples, please see the claims in the following: USD436020 (Coil hose hanger with sun shaped head member); US 5011211 (U-shaped); US 6561922 ("The golf club shaft of claim 1 wherein the portion of said shaft having a non-circular cross-section has a tear drop-shaped cross-section."); US 6478156 (bags having a tear drop shaped support); US 6554336 (suction body is heart shaped); US 6461011 (elongate, flame-shaped piece); and US 5666499 (ghost shaped image is displayed).

Clearly, shape recitations are proper, and the meanings of those used in the present claims easily satisfy the requirements of 35 USC 112. The representative patents cited just above show this.

The Examiner specifically argued that the phrase "tear drop-shaped" can't be determined. Applicant respectfully disagrees. Random House Webster's College Dictionary, on page 1370 defines the word "teardrop" as "something shaped like a falling drop of thin liquid, having a globular form at the bottom tapering to a point at the top." The term teardrop is clearly known to the public as the shape of a dropping liquid. When a search for "tear drop" or "teardrop" is done on www.google.com, a plethora of sites result, many of which include a diagram of the shape, or a photo of a tear-drop shaped object, such as a pendant, a chandelier crystal, etc. Moreover, while the sites are not affiliated with each other, all of the shapes shown on the sites are similar if not identical in shape. Applicant asserts that the term "tear drop-shaped" is widely known in the public and is therefore not indefinite.

The Examiner argued that the phrase "sun-shaped" cannot be determined. Applicants disagree because the term "sun shaped" is generally known to the public at large and even to very young children who cannot yet read as is evidenced by preschool aged children who include the sun in their drawings or paintings. A sun shape is generally circular having radiant protrusions extending therefrom. When a search is conducted on www.google.com for the term "sun shape" or "sun shaped" many sites result having diagrams or photos of sun-shaped mylar balloons, sun-shaped mirrors, coloring pages, to name a few. All of the shapes shown in the photos or drawings are similar which supports Applicant's assertion that the term "sun-shaped" is known by the public and is therefore not indefinite as asserted by the Examiner.

The Examiner argued that the phrase "ghost-shaped," was indefinite because structural features encompassed by the phrase can't be determined. Again, Applicant respectfully disagrees with the Examiner and asserts that the term ghost-shaped is also known by members of the public at large. Many Halloween greeting cards, Halloween decorations and the like include drawings of ghosts. Upon conducting a search on www.google.com for "ghost shape" and "ghost shaped" numerous sites resulted showing photos of ghost shaped suckers or lollipops, mylar balloons, muffin tins, to name a few. Yet another example of a ghost-shape is the animated Caspar the Friendly Ghost. Applicants again assert that the term "ghost shaped" is sufficiently definite because it is so widely abundant in the public and members of the public readily appreciate what is meant by the term, "ghost shaped."

Even more telling, a young child using this toy would have no difficulty identifying these shapes. Applicant's counsel drew shapes for a four-year-old child asking the child to tell what was drawn. In each instance the four year old quickly identified the tear-drop, sun, fire, and ghost shapes. The child even corrected counsel's drawings and showed counsel how counsel could draw other sun and fire shapes!

If a child can recognize such shapes, how could skilled workers, including professional psychologists fall short as suggested by the Examiner?

Finally, MPEP Section 2137.04 states that breadth of a claim is not to be equated with indefiniteness. Applicants believe that the claims as recited are definite and the Examiner may be equating definiteness with breadth. If the scope of the subject matter

embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).

Applicants hereby request that the Examiner withdraw the indefiniteness rejections upon reconsideration.

Claim Rejections - 35 USC § 101

The Examiner rejected claims 13-16 and 18 under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

Applicants respectfully submit that the claims satisfy the requirements of 35 USC 101. Applicants claim a "method of exploring emotional experience" that is therapeutic in nature. As described in the specification, the claimed method allows emotional conditions to be assessed or diagnosed by persons such as psychologists or other health professionals as well as to be therapeutically treated. See specification at page 1, lines 10-15; page 1, lines 23-30; page 2, lines 14-18; page 2, lines 21-30; page 7, lines 7-18. The user interacts with the toy visually, kinesthetically, and linguistically. With the help of parents, teachers, health care professionals, practice of the method helps a user to name and explore emotion in a controlled way.

Psychological methods of practice have long been deemed to constitute patentable subject matter under Section 101, notwithstanding the fact that these methods deal with intangible subject matter such as the mind and behavior. Please refer to the many patents, for instance in class 434, subclass 236. Just a few representative patents in this class/subclass include US 6626677 titled *Method for enhancing work related creative thinking and team building skills*; US6626678 titled *Method of providing mental stimulus to a cognitively impaired subject*; US6602076 titled *Method of teaching through exposure to relevant perspective*; and US6540518 titled *Educational system, method and doll for teaching individuals their emotions employing sets of faces expressing different emotions with plural states* just to name a few.

Claims in psychological patents such as these have demonstrable utility even though a specific tangible result may or may not be achieved. No physical transformation is required.

Clearly, the psychological utility of the claims clearly satisfies the requirements of Section 101. Withdrawal of the rejection is respectfully requested.

Claim Rejections - 35 USC § 103

Claims 1, 4, and 6-16 stand rejected under 35 USC 103(a) as being unpatentable over Van Hoose in view of Shaver et al. The Examiner stated that, "Van Hoose discloses an interactive toy containing most of the elements of the claims including, providing a plurality of playpieces (Fig. 3) as required by claims 1 and 13, each playpiece symbolic of particular emotion (col. 2, lines 35-47) as required by claims 1 and 13, each playpiece comprising a unique shape with respect to the other playpieces (elements 29, 31, 33, 35, 37 and 39) as required by claims 1 and 13, providing a container comprising a storage chamber as required by claims 1 and 13 (element 23 and 45), a first playpiece generally symbolic of love (35) as required by claim 4, a second playpiece generally symbolic of sadness as required by claim 4 (33), a third playpiece generally symbolic of fear (29) as required by claim 4, one or more playpieces comprising one or more panels enclosing a stuffing material (col. 5, lines 18-21 and fig. 3, element 35), a container being heart shaped and a plush pillow bag as required by claims 11 and 12 (elements 23 and 45). The Examiner continued stating that Van Hoose further discloses interacting with a toy as required by claims 13-15 (col. 3, lines 6+). Regarding the shapes required by claims 6-9, it was considered that the shapes of the playpieces, 29, 31, 33, 35, 37 and 39, read on all the shapes required (as best understood). Furthermore, the specific shapes encompassed by claims 6-9 are an obvious design choice in that the applicant discloses no critical need or advantage for them."

There are significant differences between the claimed inventions and the primary reference Van Hoose. Although Van Hoose teaches each playpiece having a color (col. 2, lines 36-47), Van Hoose repeats the use of color. Playpieces 33 (smiling lips) and 35 (heart) of Van Hoose are both red.

Not only does Van Hoose fail in that the colors of each playpiece are not unique, Van Hoose also fails in that the shapes of the playpieces are not unique. Van Hoose

playpieces 35, 45, and 46 are all heart-shaped. Moreover, inside one of the heart-shaped playpieces 45 or 46 (the specification of Van Hoose is unclear as to which heart contains the cards) are twelve (47-58) heart-shaped cards containing questions. While certain of these playpieces originate in different pouches located throughout the doll's body, they are intended to be played with during the same play session. Moreover, such playpieces may be placed in the same pouch during play. Van Hoose also teaches playpieces or objects that are flesh colored strips of fabric with the center being of a gold color fabric (Col. 2 lines 32-34 and shown in Fig. 1 as number 28). While only one bandage is illustrated in Figure one, the specification clearly states that more than one bandage is found in the "imagination 27."

Therefore, Van Hoose repeats both color (red and flesh color) and shape (both hearts and strips) in playpieces.

Thus, Van Hoose fails to teach, motivate, or suggest that multiple features of the playpieces should be unique. Van Hoose further fails to teach, motivate, or suggest a combination of unique playpiece features including, shape, color, and expression.

Shaver fails to cure the deficiencies of Van Hoose. Shaver discloses an interactive toy containing multiple sets of playpieces. One set uses playpieces with unique facial expression for demonstrating a particular emotion (col. 4, lines 43-46, and figs. 9a-9j). Neither unique color nor unique shape are incorporated into this set.

In a second separate set, the playpieces have a unique color. See col. 4, lines 58 to 65. These pieces, though, have neither a unique facial expression thereon nor unique shape.

A third set has numbers on it. See col. 5, lines 1-6.

In short, Shaver fails to integrate a combination of even two, let alone three, unique features into a single playpiece. Indeed, it is essential to the Shaver's intended mode of use that facial expression and color be separately introduced to the user via separate playpiece sets. The different colored sets of Shaver are not used at the same time, but rather are to be used sequentially. None of the Shaver playpieces combine more than one unique feature in any one playpiece, and to the extent different expression/colors are used, these must be implemented in separate piece sets according to the mode of practice contemplated by Shaver.

Shaver also fails to teach the claimed aspect of unique shape in any respect. All of the Shaver playpieces are disk shaped. Thus the shape of the Shaver playpieces is generic

with respect to emotion. There necessarily is no symbolic correlation between shape and the emotion depicted in the playpiece.

In view of the deficiencies of Shaver, Shaver is unable to cure the deficiencies of Van Hoose. Van Hoose incorporates two features into a playpiece. Nothing in Van Hoose or Shaver suggests a third should be used. Indeed, Shaver expressly teaches away from this by having a system in which expression and color are to be introduced separately.

While Van Hoose incorporates two features into a playpiece, it also teaches that the color and shape need not be unique. Shaver requires color and expression to be bifurcated into separate piece sets, and so cannot cure this deficiency.

Van Hoose fails to require that each playpiece have a unique shape or that the shape could be correlated to the emotion being depicted. Shaver teaches playpieces whose shape is the same and so cannot cure this deficiency.

Neither document teaches or suggests that a trio of unique features (unique expression and unique color and unique shape) are to be present in a single playpiece. Van Hoose might teach two features incorporated into a piece, but there is no requirement that the two are unique individually from features in other pieces. Since Shaver bifurcates features, Shaver can't cure this deficiency of Van Hoose.

The Examiner argued that it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to incorporate the teachings of Shaver in the toy of Van Hoose for the purpose of further assisting children with recognizing emotions, thoughts and actions in daily life. From this broadly stated objective, the Examiner then asserts that it would be obvious from Van Hoose and Shaver to provide playpieces which are distinctive in appearance from each other in accordance with the claims.

Applicant disagrees that this broadly stated objective provides the requisite motivation or suggestion to combine Van Hoose and Shaver in the manner proposed by the Examiner, because stating this objective so broadly in no way suggests any particular path by which the broad objective (to assist children to manage emotions) is to be reached. Van Hoose uses one path. Shaver uses another. The present invention uses a third. Without using applicant's specification as a road map, Van Hoose and Shaver teach paths that lead elsewhere.

In short, the Examiner's broadly stated motivation for managing emotions that merely contemplates such a result to be achieved begs the question as to how the result is to be achieved. As highlighted by the different approaches of Van Hoose and Shaver and by the deficiencies of Van Hoose and Shaver noted above, there is no proper basis to pull features artificially from Shaver and substitute them into Van Hoose. This is especially the case when Shaver teaches a bifurcated approach to emotional exploration in terms of playpiece features, not an integrated approach.

It must be emphasized that the mere existence of a feature in one reference, e.g., Shaver, does not make it obvious to use the feature in another reference, e.g., Van Hoose. There must be a specific teaching or suggestion or motivation to make the combination, and neither Van Hoose nor Shaver provide this.

The proposed combination is thus artificial and unsupported by a proper teaching, motivation, or suggestion.

The difference in how the toys may be used among Van Hoose, Shaver, and the present invention further highlights the patentable significance of the claims. Applicant's invention, incorporating three unique features into a single playpiece, is used differently than either the toys of Shaver or Van Hoose. In playing with Applicant's invention a child may react to any one of three features of a given playpiece, thus allowing a younger or developmentally immature child to successfully use the invention linguistically, visually, or kinesthetically.

In contrast, both Shaver and Van Hoose are much more limited and potentially confusing for a young child. For instance, in the case of Van Hoose, more than one playpiece is red. If a certain child strongly associates with colors, repetition of the same color may confuse the child. Also in Van Hoose, more than one playpiece (along with a plethora of cards) are heart shaped and a number of playpieces are bandage-shaped. This could again confuse a child who strongly associates with the shape of an object or who is intellectually less advanced. Shaver is complicated in that it requires a number of playpiece sets to define or describe the same emotion. While this may be useful to more deeply examine an emotion of an older child or an intellectually advanced child, it could be overwhelming for other children. Applicant's invention is useful for less mature minds due

to its incorporation of three unique features into a single playpiece. It is both advanced and simple at the same time.

Thus, it is respectfully requested that the rejection of the claims over Van Hoose and Shaver be withdrawn upon reconsideration.

The Examiner rejected claims 17 and 18 under 35 USC 103(a) as being unpatentable over Van Hoose in view of Shaver et al. (as stated above) and further in view of Childswork/Childsplay "Feelings Frogs Game." The Examiner cited the Childswork/Childsplay reference for the element of each playpiece comprising textual information indicative of a particular emotion corresponding to a playpiece as required by claims 17-18. Even if this combination were to be made, the Childswork/Childsplay reference still does not overcome the other shortcomings of Van Hoose and Shaver as detailed above. Accordingly, it is respectfully requested that this rejection be withdrawn upon reconsideration.

CONCLUSION

In view of the above remarks, it is respectfully submitted that the claims and the present application are in condition for allowance. Approval of the application and allowance of the claims is earnestly solicited. In the event that a phone conference between the examiner and the Applicant's undersigned attorney would help resolve any remaining issues in the application, the Examiner is invited to contact either Amy Hoffman at (651) 275-9807 or David Kagan at (651) 275-9804.

Respectfully Submitted,

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